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| 10/550,063 | 09/21/2005 | Hiroshi Kamo | 1843.1005 | 5764 |
| 21171 | 7590 | 02/09/2009 | EXAMINER | |
| STAAS & HALSEY LLP | | | ZIMMER, MARC S | |
| SUITE 700 | | | ART UNIT | |
| 1201 NEW YORK AVENUE, N.W. | | | PAPER NUMBER | |
| WASHINGTON, DC 20005 | | | 1796 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/550,063

Applicant(s)

KAMO ET AL.

Examiner

MARC S. ZIMMER

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-12 and 17 is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 13-16 is/are rejected.
- 7) ☒ Claim(s) Z is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF-08)
Paper No(s)/Mail Date 12/24/08.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, and 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kamo, JP 2002-241601.

Applicant is encouraged to review the Examiner's February 11, 2008 correspondence for a more thorough explanation as to the relevance of this document.

Applicant has added to claim 1 a limitation that defines the thickness of the resin layer containing at least 50% PPE. In their remarks, they comment that, although the Kamo disclosure contemplates thicknesses as low as 10 microns in paragraph [0038], the Examples all report thicknesses of 300 microns. Applicant alleges that embodiments of the prior art film where the thickness is consistent with the claimed range will not have the properties sought in that invention but this assertion appears to be rooted entirely in conjecture. Even in the broader disclosure, it seems unlikely that Kamo would advocate any thickness that was not practicable in their invention.

"Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments." *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843

(Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989). In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191USPQ 90 (CCPA 1976).

Claims 1-2, 5-6, 8, 13-14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada et al., JP 3-126538.

Applicant is encouraged to review the Examiner's February 11, 2008 correspondence for a more thorough explanation as to the relevance of this document.

It is, again, Applicants' position that Takada fails to disclose a release film wherein the film contains a resin layer comprising at least 50 wt.% of PPE and the layer has a thickness of 10 to 100 microns. The Examiner respectfully disagrees. It is said of the resin varnish, which corresponds to the PPE layer of the instant invention, that it has a thickness upon drying of 5-500 microns. Insofar as the claimed range represents twenty percent of that of the prior art and, more importantly, the Example discloses a resin layer having a thickness of 25 microns (though it is appreciated that, in that instance, the PPE content is lower than what is required of the claimed film), the Examiner regards the instant invention as *prima facie* obvious particularly since there is no documented criticality associated with the inserted range.

Allowable Subject Matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10-12 and 17-18 are allowable. The Examiner could not ascertain why one of ordinary skill would be motivated to laminate together the PPE/crystalline PE layer taught by Kamo and an elastomer layer. In Takada, the PPE-containing composition is coated onto a plastic film or metallic foil, there being no motivation to replace either of these substrates with an elastomer.

As for claim 18, Takada teaches hot pressing the PPE resin layer to a copper foil but the layer that actually contains the release characteristics is separated from the resin layer prior to doing this hence the limitations of the claim are not satisfied.

The receipt of EP 480 766 A2 for the Examiner's consideration is acknowledged. Insofar as that document would serve to reject any claim not already rejected but the prior art of record, its relevance to the patentability of the claims will not be summarized at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARC S. ZIMMER whose telephone number is (571)272-1096. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

February 5, 2009

/Marc S. Zimmer/
Primary Examiner, Art Unit 1796